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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681

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SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER
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PHAN, HUY Q

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/589,217	Applicant(s) COOPER, DAVID	
	Examiner Huy Q. Phan	Art Unit 2617	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

  
 GEORGE ENG  
 SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: 1. Applicant's arguments, see REMARKS, have been fully considered but they are not persuasive.

a) Applicant argued that "the mobile station of Bridges et al. does not compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover, as recited in Applicant's amended Claim 28, and similarly recited in amended Claims 3, 8, 16, 18, 25 and 29" (see REMARKS). The examiner respectfully disagrees. Bridges clearly discloses "Because some markets operate using multiple SIDs, PSLs/IRDBs will need to be administered on a per SID basis" and/or "If more than one preferred or target system exists for a given region, then the preferred systems in an PSL/IRDB entry may be listed in order of preference and/or the air interface technology may be provided for each preferred system so that the mobile station may select the most appropriate system for that region" (see cols. 12-13). Since, Bridges also discloses "The method comprises receiving a signal transmitted by a wireless carrier containing the wireless carrier's identity, comparing the wireless carrier's identity to the database of preferred wireless carrier identities stored in the mobile station, and switching a communications mode within the mobile station so as to obtain service from the highest priority wireless carrier available" (see cols. 6-7). Consequently, when the mobile station of Bridges is capable and/or operated using multiple SIDs, it must compare the list of multiple SIDs with the PSLs/IRDBs; therefore, the mobile station of Bridges et al. does compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover.

The examiner relies upon reference, as a whole, to anticipate the instant claims, but reference's specific citations to pinpoint pertinent passages to aid in the understandings of the reference as applied to the particular claimed elements.

b) In response to applicant's arguments that the combination of Tiedemann, Jr. and Bridges do not disclose all the limitations in claims 3 and 25 (see REMARKS), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Tiedemann, Jr. was used to teach all the limitations of the claims except the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment". Further, Bridges was used only to teach the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5)".

c) In response to applicant's arguments that the combination of Tiedemann, Jr. and Bridges do not disclose all the limitations in claims 3 and 25 (see REMARKS), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Tiedemann, Jr. was used to teach all the limitations of the claims except the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment". Further, Bridges was used only to teach the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5)".

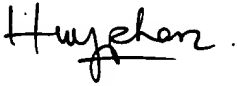
d) In response to applicant's arguments that the combination of Van Den Heuvel and Bridges do not disclose all the limitations in claims 16-18 and 20 (see REMARKS), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Van Den Heuvel was used to teach all the limitations of the claims except the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment". Further, Bridges was used only to teach the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of

the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5)".

e) In response to applicant's arguments that the combination of Tiedemann, Bridges and Chang do not disclose all the limitations in claim 5 and the combination of Van Den Heuvel, Bridges and Chang do not disclose all the limitations in claims 8-10 (see REMARKS), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It appears that Tiedemann and Bridges were used to disclose all the limitations in claim 5 except a step of incrementally adding to or subtracting from the list of available networks. Chang was used to teach a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22). Van Den Heuvel and Bridges were used to disclose all the limitations in claims 8-10 except a step of incrementally adding to or subtracting from the list of available networks. Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22). Thus both combinations above disclose all the claimed limitations of claim 5 and claims 8-10, respectively.

f) In response to applicant's arguments that the combination of Van Den Heuvel, Bridges and Gourgue do not disclose all the limitations in claim 21 (see REMARKS), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It appears that Van Den Heuvel and Bridges were used to disclose all the limitations in claim 21 except wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. Gourgue was used to teach wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. Thus, the combination of Van Den Heuvel, Bridges and Gourgue disclose all the claimed limitations of claim 21.

With all the reasons stated above, the rejection is deemed proper and still stands..



Examiner: Phan, Huy Q.

Date: 01/11/2007